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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,607	08/30/1999	WILLIAM M. PARROTT	008193-20001	9412

7590 08/28/2003

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EXAMINER

MEISLAHN, DOUGLAS J

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/385,607

Applicant(s)

PARROTT, WILLIAM M.

Examiner

Douglas J. Meislahn

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 9, 10, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 9 recites the limitation "the program memory" in the second line. There is insufficient antecedent basis for this limitation in the claim. The examiner has treated the claim as though it depended from claim 8, which would provide antecedent basis for the offending phrase.
4. The term "substantial" in claim 13 is a relative term which renders the claim indefinite. The term "portion" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2132

6. Claims 1-4, 8, 9, 11-13, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Shih (6490637).

In lines 18-28 of column 3, Shih describes a modem, element 22 in figures 1 and 2, that includes a serial number within a flash ROM, element 70. Serial numbers are unique identifying indicia, and so the memory anticipates the first clause of applicant's first claim. Element 100 of figure 3 states that the unique serial number is sent out. This reads on the second clause of claim 1.

With respect to claim 2, the unique serial number is needed by the modem and hence integral. Claim 3 is anticipated because data stored in a ROM, such as the serial number, is a series of bits and lines 24-28 say that the serial number is read and sent. Flash ROMs read on memory arrays and thus anticipate claim 4. Claim 11 is the physical device for the method of claim 1 and is rejected for largely the same reasons. Controller 72 is applicant's processor and executes commands from a program memory, directly RAM 76 but indirectly ROM 70. Aspects of the third clause have been shown above. The unique serial number is stored integrally because flash memory is nonvolatile. With respect to claims 8 and 12, the unique serial number is stored in ROM 70, which is the original home of the program, as detailed in lines 3-17 of column 3. Furthermore, flash memory can only be erased in blocks. As far as claims 9 and 13 are understood, this fact meets their limitations. Flash ROM is nonvolatile memory and hence meets the limitations of claim 20.

7. Claims 1, 5, 11, 14, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hall, Jr. et al. (6308281).

In the first full paragraph in column 10, Hall, Jr. et al. teach a modem that has a unique serial number burned therein. This serial number is sent from a client to a gateway. As such the first claim is anticipated. Claim 11 is rejected for largely the same reasons as claim 1. "Burned into a modem" anticipates permanently fixing the serial number in the modem and hence claims 5 and 14.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall, Jr. et al. in view of Blodgett (6163489).

Hall, Jr. et al. shows a modem that has a unique serial number "burned" into it. They do not say that the data is burned in by blowing fuses. In lines 19-21, Blodgett teaches storing data by blowing fuses. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the fuse-blowing memory described by Blodgett as the burned memory in Hall, Jr. et al.

10. Claims 7 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall, Jr. et al. in view of Doshi et al. (6349138).

Hall, Jr. et al. shows a modem that has a unique serial number "burned" into it. They do not stipulate that the unique serial number is encrypted when it is transmitted. In lines 4-7 of column 24, Doshi et al. teach encrypting a modem's serial number,

thereby protecting the number from illicit viewing. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to encrypt the serial number that Hall, Jr. et al. transmit, as taught by Doshi et al., in order to protect the number.

11. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shih in view of Doshi et al. (6349138).

Shih shows a modem that has a unique serial number stored in flash ROM. He does not say that the unique serial number is encrypted when it is transmitted. In lines 4-7 of column 24, Doshi et al. teach encrypting a modem's serial number, thereby protecting the number from illicit viewing. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to encrypt the serial number that Shih transmits, as taught by Doshi et al., in order to protect the number.

12. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shih in view of Haynes (WO 97/19414) and Bhatia et al. (6118768).

Shih shows a modem that has a unique serial number stored in flash ROM. He does not say that the serial number is used as an account number for a financial transaction account. In lines 18-28 of page 4, Haynes teaches a transaction identifier that reduces the risk of fraud and that includes a modem number. In lines 33-38 of column 13, Bhatia et al. display the storage of data in a modem in order to transparently user that data. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for the serial number in Shih to be used as an account number in order to transparently prevent fraud.

13. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall, Jr. et al. in view of Haynes.

Hall, Jr. et al. shows a modem that has a unique serial number "burned" into it. They do not say that the serial number is used to identify an aspect of a financial transaction account. In lines 18-28 of page 4, Haynes teaches a transaction identifier that reduces the risk of fraud and that includes a modem number. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for the serial number in Hall, Jr. et al. to be used as part of a transaction identifier in order to prevent fraud, as taught by Haynes.

14. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall, Jr. et al. and Haynes as applied to claim 18 above, and further in view of Bhatia et al.

Hall, Jr. et al. and Haynes show a modem serial number that is used to identify an aspect of a transaction account. They do not say that it is the actual account number. In lines 33-38 of column 13, Bhatia et al. display the storage of data in a modem in order to transparently user that data. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store the account number in the modem, as implied by Bhatia et al., in order to provide transparent access to the system described by Hall, Jr. et al. and Haynes.

15. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shih in view of Micali (5793868).

Shih shows a modem that has a unique serial number stored in flash ROM. He does not say that the serial number is compressed. In lines 10-15 of column 6, Micali

Art Unit: 2132

teaches compressing serial numbers. This reduces the amount of space that they consume. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to compress the serial number in Shih, as taught by Micali, in order to conserve memory space.

16. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall, Jr. et al. in view of Micali (5793868).

Hall, Jr. et al. show a modem that has a unique serial number "burned" into it. They do not say that the serial number is compressed. In lines 10-15 of column 6, Micali teaches compressing serial numbers. This reduces the amount of space that they consume. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to compress the serial number in Hall, Jr. et al., as taught by Micali, in order to conserve memory space.

17. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shih and Micali as applied to claim 21 and further in view of Jones (5500681).

Shih and Micali show a modem that has a unique, compressed serial number stored in flash ROM. They do not say that the serial number is stored in compressed image format. In lines 1-4 of column 9, Jones discusses converting an identification number to an image format and storing the result. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store Shih's serial number as a compressed image, whereby it could be used as a seal.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hraster et al. (6324267) – lines 31-47 of column 3 and Chuah (6377548) – lines 2-7 of column 26.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached on between 9 AM and 6 PM, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón can be reached on (703) 305-1830. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Douglas J. Meislahn
Examiner
Art Unit 2132

DJM